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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,433	03/10/2004	Thomas Michael St. James	0521-0001	4447

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EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT PAPER NUMBER

3676

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,433

Applicant(s)

JAMES, THOMAS MICHAEL ST.

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-23 and 25-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13-20, 22, 23, 25-33, 35-37 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 10, 21, 34, 38 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09072004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed 11/15/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: new Figure 8 and in the specification, in new paragraph [0024.2], the last two sentences, beginning with "Although member 514...", are new matter not supported by the original disclosure of claims 14-24. The original claims 14-24 disclosed vertically and horizontally spaced holes, but did not define an inclined surface or a stair-stepped member as now disclosed in the drawing figure and paragraph 24.2.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

2. Claim 42 is objected to because of the following informalities: in line 1, "ace plate" should be --face plate--. Appropriate correction is required.

Allowable Subject Matter

3. Claims 10,21,34,38,39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,4-6,8,9,11,13,14,17,19,20,22-25,27-30,32,33,35-37,40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanutti 5,477,710 in view of Stanich 4,882,918. Stefanutti clearly teaches a padlock body and shackle shield member having sides to encompass a padlock therein and comprising integrally formed angled arms 6 which have elongate holes 16,18 therein laterally spaced to receive the legs of a padlock shackle. Stefanutti fails to teach vertically offset holes. Stanich teaches a padlock protector comprising a shield having a rear surface with vertically offset portions (15,22) and with integral arm members having shackle receiving openings (18,19a) therein and wherein the laterally and vertically offset arms receive the curved shackle (S) accordingly. With respect to claims 8,9,19,20,32,33, the shield further provided with a semicircular cutout (at 22 in Fig. 4) in the lower end to receive a combination dial therein and an access opening in the front face (at 11 in Fig.1). Furthermore, Stanich teaches the use of indicia on the face of the shield (see figures 1,17,19 especially, indicating a heart, unicorn or soccer ball – note in col. 6, lines 13-17 that Stanich teaches “virtually any shape” may be used). It would have been obvious to one of ordinary skill in the art to modify the shield of Stefanutti by vertically spacing the

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shackle holes, providing a semicircular cutout for the padlock face and providing indicia on the shield, all as taught by Stanich to securely receive the padlock within the shield and limit movement therein which could lead to tampering. It is noted that the method limitations of claim 37 are considered inherent to the use of the device as disclosed by Stefanutti and Stanich.

3. Claims 3,15,16,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanutti '710 in view of Stanich '918 as applied to claims 1,14,25 above, and further in view of Wightman 5,303,568. Stefanutti fails to specify the material used for the shield. Wightman teaches a padlock shackle shield comprised of a hardened steel. Accordingly, it would have been considered an obvious matter of design choice in providing a rigid construction to the shield to provide a well known hardened metal alloy for the shield of Stefanutti, as modified by Stanich.

4. Claims 7,18,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanutti '710 in view of Stanich '918 as applied to claims 1,14,25 above, and further in view of Anderson D330,843. Anderson teaches the use of a padlock shield member resembling a police badge. Stanich also clearly teaches in Col. 6, lines 13-17 that the shield member may be formed in various shapes resembling specific objects. Accordingly, it would have been considered an obvious matter of design choice to modify the shield of Stefanutti by providing a shape resembling a police badge as clearly taught by Stanich and Anderson.

Response to Arguments

5. Applicant's arguments with respect to claims 1-11, 13-23,25-42 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's amendments, the previously cited Stefanutti reference is now applied to the claims in combination with the previously applied Stanich reference to clearly show a shield which extends beyond the shackle and covers a portion of the padlock body.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

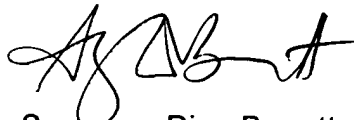
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 703-308-0825. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb